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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,589	07/29/2003	Vantresa Stickler	08049.0923	1662
22852	7590	11/16/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				BORISSOV, IGOR N
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
11/16/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/630,589	STICKLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Igor N. Borissov	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 October 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) 1-32, 48, 64, 80; 95 and 96 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 33-47, 49-63, 65-79 and 81-94 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

Amendment received on 10/02/2007 is acknowledged and entered.

Applicant's election without traverse of claims 33-47, 49-63, 65-79, and 81-94 in the reply filed on 10/02/2007 is acknowledged. Accordingly, claims 1-32, 48, 64, 80, 95 and 96 have been withdrawn from consideration. Currently, claims 1-96 are pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the claims is directed to: to a server or computer readable medium.

The preamble of claim 65 indicates that the claim is directed to a method, while the body of the claim recites structural elements. It is not clear to what extend the structural elements represent method steps.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 49 and 65 are rejected under 35 U.S.C. 101 because each of said claims includes two statutory classes of invention: an apparatus and a process.

Claim 49 is directed to a system, while reciting various components providing certain functionality, which (components) can be understood as computer-readable instructions embedded in a computer-readable medium (a product of manufacture), or

can be understood as merely software or code per se. Therefore, claim 49 combines two mutually exclusive statutory classes of invention.

Claim 65 is directed to a method while the body of the claim recites structural elements, thereby combining two mutually exclusive statutory classes of invention.

It must be clear from the wording of a claim that it is drawn to one or the other of mutually exclusive statutory classes of invention. A process is an act or a series of acts and from the standpoint of patentability must distinguish over the prior art in terms of steps, whereas a claim drawn to apparatus must distinguish in terms of structure. *Ex parte Lyell at 1552.*

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 33-47, 49-53, 65-79 and 81-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6,233,568 B1) in view of Sansone et al. (US 5,019,991).**

Kara teaches a method, system and computer-readable medium having computer-readable instructions embedded therein for causing a computer to implement said method for receiving payment for postage for a parcel, comprising:

Claims 33, 49, 65, and 81,

receiving from the customer mailing information for a parcel, the mailing information comprising customer-determined attributes of the parcel (Figs. 7-8A; C. 5, L. 60-67; C. 19, L. 55-65; C. 20, L. 62-67);

calculating a first postage value based on the customer-determined attributes (C. 5, L. 43-52; C. 9, L. 36-42);

transmitting data to the customer to permit printing by the customer of a mailing label for the parcel, the mailing label including an indication of the first postage value (P. 6, L. 1-2; C. 20, L. 1-3);

charging a customer account for the first postage value (C. 6, L. 12-21; C. 22, L. 13-19).

Kara does not specifically teach:

determining attributes of the parcel by the delivery system operator;

calculating a second postage value for the parcel based on the operator-determined attributes; and

transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values.

Sansone et al. teaches a method and system for certifying correctly accounted postage payment, wherein the received mail pieces are placed in a feeder-stacker unit 14 (suggests the presence of the delivery system operator; C. 3, L. 15-16. Furthermore, the use of keyboard as an data entry device at C. 4, L. 53-63 also suggest the presence of the system operator); based on inputted data calculating a value of the printed postage and, if the postage is already pre-printed, checking correctness of the pre-printed postage, and if the pre-printed postage is incorrect transmitting a postage adjustment amount to the customer account (C. 3, L. 66 – C. 4, L. 28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include determining attributes of the parcel by the delivery system operator; calculating a second postage value for the parcel based on the operator-determined attributes; and transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values, as disclosed in Sansone et al., because it would advantageously allow to avoid returning short paid mail to the sender where more postage is required, as specifically stated in Sansone et al. (C. 1, L. 34-38).

Furthermore, because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, in such case, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Claims 34, 35, 50, 51, 66, 67, 82 and 83. Kara discloses that the mailing information is received from the customer over a network (Fig. 1A).

Claims 36, 52, 68, 84. Kara discloses that the customer-determined attributes include at least one of height, length, weight, thickness, and weight of the parcel (Fig. 8).

Claims 37, 53, 69, and 85. Kara discloses that the mailing information comprises at least one of return address information, destination address information, and payment information (Fig. 8).

Claims 38, 39, 54, 70, 71 and 86. Kara discloses that the mailing information comprises at least one of return address information, destination address information, and payment information (Fig. 8).

Claim 40, 56, 72, 87. Kara discloses that the customer account is a credit card account (C. 31, L. 44).

Claims 41, 57, 73, and 88. Kara discloses that the mailing label further comprises a unique identification code for the parcel (Fig. 3B; C. 9, L. 40-43).

Claims 42-47, 55, 58-63, 74-79 and 89-94, see reasoning applied to independent claims.

***Conclusion***

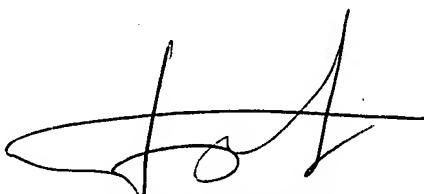
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/13/2007



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